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Luca Chiarabini

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HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER

ZURITA, JAMES H

ART UNIT

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ELECTRONIC

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ipa.mail@hp.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LUCA CHIARABINI and MANUEL GONZALEZ

Appeal 2008-4050
Application 09/925,519
Technology Center 3600

Decided:¹ March 12, 2009

Before HUBERT C. LORIN, ANTON W. FETTING, and DAVID B.
WALKER, *Administrative Patent Judges*.

WALKER, *Administrative Patent Judge*.

DECISION ON APPEAL

¹The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

The Appellants seek our review of the Examiner's final rejection of claims 10 and 27-30 under 35 USC § 134 (2002). We have jurisdiction under 35 U.S.C. § 6(b) (2002). We reverse.

The Appellants claim a method and apparatus for enabling an e-printing service solution. One object of the claimed invention is to provide an infrastructure for print on demand services provided over the Internet, with full automation of print ordering, including competitive tendering for print services, and automated printing prior to delivery of prints to a customer (Specification 3:3-6). Claim 10, reproduced below, is representative of the subject matter on appeal.

10. A method of providing on-line print services, said method comprising the steps of:

receiving at least one order for print products on-line, said at least one order having an item requiring a particular sheet material;

electronically distributing said at least one order to at least one print service provider facility;

within a said print service provider facility, electronically allocating said item to a printer device based on said printer device having said particular sheet material loaded on said printer device; and

printing said item according to said order, with said printer device, and on said particular sheet material.

THE REJECTIONS²

The Examiner relies upon the following as evidence in support of the rejection:

Blumberg	US 2003/0140315 A1	Jul. 24, 2003
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1. The Examiner rejected claims 10 and 28-30 under 35 U.S.C. § 102(e) as anticipated by Blumberg.
2. The Examiner rejected claim 27 under 35 U.S.C. § 103(a) as unpatentable over Blumberg.

ISSUE

Have the Appellants shown that the Examiner erred in finding that Blumberg discloses “electronically allocating said item to a printer device based on said printer device having said particular sheet material loaded on said printer device”?

FINDINGS OF FACT

We find the following enumerated findings to be supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

² The Examiner also rejected claim 30 under 35 U.S.C. § 112, first paragraph. The Appellants do not challenge this rejection on appeal (Br. 5).

1. Blumberg is directed to systems for on-line on-demand printing services that enable a user to interactively create and order print jobs via a computer network (Blumberg, [0027]).
2. Blumberg discloses an Internet print on demand service including software that prices and schedules a print job, accepts orders for printing the job along with delivery instructions, routes the job to a print service provider production center, and bills the user. The service interfaces with inventory databases, and bases the information it provides on availability of inventory and allowable product sets available to the user (Blumberg, [0032]).
3. Blumberg discloses a Virtual Builder User Interface that includes paper type selection, which preferably includes selection of paper grain, weight, size, color, and other features (Blumberg, [0068]). Virtual Builder maintains a list of registered printing companies, together with a description of their capabilities, their pricing and their library of pre-designed document styles (Blumberg, [0103]).
4. Blumberg teaches that an on-line on-demand print facility preferably includes its own production resources in a local production center, and additionally has access to production resources in remote production centers. The on-demand print service prioritizes print jobs and routes them to printers in the local production center and the remote production centers, based on the type of job and based on resource availability (Blumberg, [0152]).

5. Blumberg also teaches that additionally, Virtual Builder can act as a “print broker,” whereby a user specifies his job requirements, such as turnaround and price, and Virtual Builder searches among registered print companies to find the ones who can fulfill the requirements (Blumberg, [0228]).

PRINCIPLES OF LAW

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987).

“To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted) (internal quotation marks omitted).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed

subject matter and the prior art, (3) the level of ordinary skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the appellant. *Id.* at 1445. *See also Piasecki*, 745 F.2d at 1472. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See Oetiker*, 977 F.2d at 1445; *Piasecki*, 745 F.2d at 1472.

ANALYSIS

Rejection of claims 10 and 28-30 under 35 U.S.C. § 102(e) as anticipated by Blumberg.

The Appellants argue that the Examiner has not shown how Blumberg discloses “electronically *allocating said item to a printer device* based on said printer device having *said particular sheet material loaded* on said printer device”, as recited in claim 10 (Br. 8). The Appellants argue that paragraphs 105 and 172 of Blumberg, relied upon by the Examiner in the Office Action, do not disclose the disputed limitations and

[i]nstead, these passages relate to the Virtual Builder **software** of Blumberg, which allows products to be **viewed on a monitor**. According to these passages, this software may include “different user interfaces” or “specialized display engines”. Applicant respectfully submits that Blumberg cannot be shown to disclose “allocating [an] item to a printer device” when the cited passages make *no mention of a printer device*.

Furthermore, as these passages fail to disclose “allocating [an] item to a printer device”, they accordingly fail to disclose “electronically allocating said item to a printer device based on said printer device having said **particular sheet material loaded on** said printer device”. While the Office appears to rely on “clay” and “cloth” as the claimed “material”, Applicant submits that the cited passages fail to show where these mugs and t-shirts are “**loaded** on [a] printer device”. Instead, the passages discuss a specialized display engine that may be configured to view-on a computer monitor-products such as t-shirts or mugs.

(Br. 9).

The Examiner found that Blumberg discloses electronically allocating said item to a printer device:

For example prioritizing and routing orders, as jobs to one or more printer devices at the centers, at paragraph 151. Please note that orders are for specific items requiring specific sheet materials. See at least paragraph 132, concerning targeting specific output device such as a color printer

Based on said printer device having said particular sheet material loaded on said printer device:

For example, See paragraph 105, 172, for printer devices that print on materials such as paper, clay (mugs), cloth, woven fabric (t-shirts), business cards, paragraph 0169. See also specific sheet materials, as in paragraph 0028.

According to the Examiner, Blumberg discloses allocating a plurality of said print items to a plurality of printer devices, taking into account for each printer device, parameters selected from the set: availability of said printer device; a sheet material type loaded onto said printer device; an ink type loaded onto said printer device; a percentage utilization of said printer device. (Answer 4, citing at least references to routing particular printer devices based on job type and resource availability, as in paragraph 0152).

Blumberg teaches an Internet print on demand service including software that routes the job to a print service provider production center and interfaces with inventory databases, and bases the information it provides on availability of inventory and allowable product sets available to the user (Finding of Fact 2). Blumberg also discloses a Virtual Builder User Interface that includes paper type selection and maintains a list of registered printing companies, together with a description of their capabilities, their pricing and their library of pre-designed document styles (Finding of Fact 3). Blumberg further teaches that the on-demand print service prioritizes print jobs and routes them to printers in the local production center and the remote production centers, based on the type of job and based on resource availability (Finding of Fact 4). Moreover, the Virtual Builder of Blumberg can act as a “print broker,” whereby a user specifies his job requirements, such as turnaround and price, and Virtual builder searches among

registered print companies to find the ones who can fulfill the requirements (Finding of Fact 5).

We find that Blumberg fairly teaches “electronically allocating said item to a printer device”, but not doing so “based on said printer device having said particular sheet material loaded on said printer device”. Blumberg discusses generally routing jobs to particular printers in the local production center and remote production centers based on the type of job and resource capability (Finding of Fact 4), but does not explicitly teach that the specific printer is selected based on having said particular sheet material loaded. We further find that such selection is not inherent in Blumberg. The Appellants thus have shown that the Examiner erred in rejecting claim 10, and claims 28-30, which depend therefrom, as anticipated by Blumberg.

Rejection of claim 27 under 35 U.S.C. § 103(a) as unpatentable over Blumberg.

The Examiner found that Blumberg discloses all of the limitations of claim 27, but for the particular sheet material comprising canvas. The Examiner took Official Notice that it is old and well known to print on sheet materials such as cloth and other types of materials, including canvas (Answer 11). The Appellants argue that Claim 27 depends from claim 10, and the Examiner’s “Official Notice” does not cure the deficiencies of the rejection of claim 10 (Br. 16). We agree. The Appellants thus have shown that the Examiner erred in rejecting claim 27 as unpatentable over Blumberg.

CONCLUSIONS

We conclude that the Appellants have shown that the Examiner erred in finding that Blumberg discloses “electronically allocating said item to a printer device based on said printer device having said particular sheet material loaded on said printer device”.

DECISION

The decision of the Examiner to reject claims 10 and 28-30 under 35 U.S.C. § 102(e) as anticipated by Blumberg is reversed. The decision of the Examiner to reject claim 27 under 35 U.S.C. § 103(a) as unpatentable over Blumberg is reversed.

REVERSED

Appeal 2008-4050
Application 09/925,519

LV:

HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400